

## **REMARKS**

Applicant requests reconsideration and allowance of the subject patent application in light of the changes above and the remarks that follow. Claims 1, 4, 6, 7, 9-14, 16-25 and 27-36 are pending.

### **Claim Objections**

Claims 23 & 27 were objected to because the term "computer readable medium" is allegedly not defined in the specification. Applicant respectfully traverses the objection to claims 23 & 27. There is no requirement that the subject matter of a claim be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. (*Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985); M.P.E.P. § 2163.02.) "A claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible." (M.P.E.P. § 2173.02, *citing Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004); M.P.E.P. § 2173.02.)

In the Office Action, it appears that the Examiner has made no attempt to discern the meaning of the term "computer readable medium." Nor has the Examiner offered any reasons as to why the term would be unclear to one of ordinary skill in the art. To assist the Examiner, exemplary computer readable media are described in Applicant's published specification at paragraphs 0020-0021, and in FIG. 1. For instance, paragraph 0020 states, "The computer 2 includes a Central Processing Unit (CPU) 6, a main memory which is typically implemented in the form of Random Access Memory (RAM) 8, a static memory that can comprise a Read Only Memory (ROM) 10, and a storage device, such as a magnetic or optical disk 12."

Applicant submits that one of ordinary skill in the art would understand the term "computer readable media" and, given the above-noted disclosure, the term "computer

readable medium" is sufficiently supported in the specification. Accordingly, it is requested that the Examiner reconsider and withdraw the objection to claims 23 & 27.

#### Objection to the Specification

The specification was objected to as failing to provide proper antecedent basis for the claimed "computer readable medium." This objection is improper for the same reasons set forth above with regard to claims 23 & 27. Applicant, therefore, requests that the objection to the specification be withdrawn.

#### Claim Rejections

Applicant traverses the rejection of claim 1 under 35 U.S.C. §103(a) as allegedly not being patentable over U.S. Patent No. 6,628,310 to *Hiura et al.* ("*Hiura*") in view of U.S. Patent No. 6,957,395 to *Jobs et al.* ("*Jobs*").<sup>1</sup>

Claim 1 recites, *inter alia*, "a first graphical user interface (GUI) element associated with a first application running on a computer and a corresponding, second GUI element associated with a second application," and "removing from the computer display the first GUI element associated with the first application and replacing the first GUI element with the corresponding, second GUI element associated with the second application." (Emphasis added). *Hiura* does not disclose or suggest at least these features of claim 1.

The Examiner points to FIG. 11 for allegedly illustrating the above-noted features. (Office Action, pp. 7-8.) FIG. 11 shows a screen 15 including a first window 211 and a second window 212. (*Hiura*, col. 10:63-67.) A *portion* of window 211 may be turned over on screen 15 to unveil a portion of window 212. (*Id.*) The Examiner asserts that an object in window 211 and an object in window 212 correspond to the claimed "first GUI element" and "second GUI element," respectively. (Office Action, p. 7.) Applicant disagrees.

<sup>1</sup> The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

The object in window 211 appears to be a photograph. The object in window 212 appears to be a text document. But these objects could be any content and could be located anywhere on screen 15. *Hiura* does not disclose a relationship between windows 211 & 212 other than being displayed on screen 15 at the same time. Thus, the object in window 212 cannot be considered as "corresponding" to the object in window 211.<sup>2</sup>

It does not appear that the Examiner gave the claim term "corresponding" any meaningful weight. This is improper. When evaluating claims under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight. (*Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) aff'd mem. 738 F.2d 453 (Fed. Cir. 1984); M.P.E.P. § 2173.03.)

The term "corresponding" should be given its plain meaning consistent with Applicant's specification. (*LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003); M.P.E.P. § 2173.01.III.) A plain meaning of "corresponding" is "having the same or nearly the same relationship" (*The American Heritage® Dictionary of the English Language*, 4th Ed., retrieved January 06, 2009, from Answers.com Web site: <http://www.answers.com>.) In addition, an exemplary definition of "correspond" is "to be similar or equivalent in character, quantity, origin, structure, or function." (*Id.*)

The photo of window 211 and the document of window 212 do not have "the same or nearly the same relationship;" nor are they "similar or equivalent in character, quantity, origin, structure, or function." Thus, the purported objects are not "corresponding" to one another. Accordingly, *Hiura* does not disclose or suggest "a first graphical user interface (GUI) element associated with a first application running on a computer and a corresponding, second GUI element associated with a second application," and "removing from the computer display the first GUI element associated with the first application and

<sup>2</sup> Applicant made similar arguments in the Amendment filed June 23, 2008. (See p. 11, 3rd full paragraph.) However, the Examiner did not particularly respond to this argument. (Final Office Action, pp. 7-8.) In any subsequent communication (other than a Notice of Allowance), Applicant respectfully requests that the Examiner explain how the purported object in *Hiura's* window 211 is considered to "correspond" to the purported object in window 212.

replacing the first GUI element with the corresponding, second GUI element associated with the second application," as recited in claim 1. (Emphasis added.).

Furthermore, *Hiura* fails to disclose or suggest "removing from the computer display the first GUI element associated with the first application and replacing the first GUI element with the corresponding, second GUI element associated with the second application" (emphasis added), as recited in present claim 1. In FIG. 11, the photo of window 211 is not removed from screen 15. Only a portion of window 211 is turned over on a screen 15 to unveil a portion of window 212. (*Id.*) (*Hiura*, col. 10:63-67.) A large portion of the photo is still displayed on screen 15.

The Examiner alleges that *Hiura's* process is exactly the same as that illustrated in FIGs. 2a & 2b of Applicant's disclosure. In particular, the Examiner asserts, "application 32 is removed from the computer display and replaced by the application 34, the application 32 remains on the computer display. The application 32 just becomes inactive but [is] still displayed on the computer screen." (Office Action, p. 8.) On the contrary, the Examiner seems to have misinterpreted FIGs. 2a & 2b.

In the exemplary embodiment illustrated in FIGs. 2a & 2b, a first menu bar 32 is associated with a word processing application, which displays a window including a text document. A second menu bar 32 is associated with a drawing application, which displays a window including a graphic document. When the drawing application is made active, first menu bar 32 is removed and replaced with second menu bar 34. But both the windows and their content remain on the display.

In contrast, *Hiura* discloses that all the content remains displayed on screen 15. Indeed, "removing" the content of the first or second windows disclosed by *Hiura* would be contrary to the purpose stated in *Hiura*, which is to allow a user peek behind a portion of window while retaining it on the display. (*Hiura*, col. 1:60-35.) That is, when a portion of window 211 is "turned-over," the content of window 211 is neither "removed" nor "replaced"

with the content of the window 212. (*Id.*) Accordingly, *Hiura* cannot be considered to disclose or suggest "removing ... and replacing the first GUI element with the corresponding, second GUI element" (emphasis added), as recited in present claim 1.

*Jobs* does not overcome *Hiura's* deficiencies. The Examiner relies on *Jobs* for its purported disclosure of "detecting when the first application is active, user selection of the second window to make the second application active." (Office Action, p. 4.) However, *Jobs* does not disclose or suggest the above-identified features of claim 1.

Accordingly, when *Hiura* and *Jobs* are taken individually or in any proper combination, these patents cannot be considered to disclose or suggest the subject matter recited in Applicant's claim 1. *Hiura* and *Jobs*, therefore, cannot support a rejection of claim 1 under Section 103. Claim 1 is therefore allowable over *Hiura* and *Jobs*, and so are claims 4, 6, 7, 9-13 and 24 at least due to their dependence from claim 1.

Claims 14, 23, 28, 31 and 34, although of different scope than claim 1, recite subject matter similar to that recited in claim 1. Thus, claims 14, 23, 28, 31 and 34 are allowable over *Hiura* and *Jobs* for similar reasons to those set forth above with regard to claim 1. Claims 16-22, 24, 25, 27, 39, 30, 32, 33, 35 and 36 are allowable due to their corresponding dependence from claims 14, 23, 28, 31 and 34.

### **Conclusion**

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

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